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PATENT
09/589,666

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : Group Art Unit: 2176
: Examiner: P. J. Smith
Balijeet S. Baweja et al. : Intellectual Property
Serial No: 09/589,666 : Law Department - 4054
Filed: 06/08/2000 : International Business
Title: DISTRIBUTING CONDENSED : Machines Corporation
VERSIONS OF DISPLAYABLE : 11400 Burnet Road
INFORMATION IN HYPERTEXT : Austin, Texas 78758
MARKUP LANGUAGE DOCUMENTS : Customer No. 32,329
TRANSMITTED ON THE WORLD WIDE :
WEB TO PERSONAL PALM-TYPE :
DISPLAY COMPUTERS :
Date: 9/13/05 :

CERTIFICATE OF MAILING

I hereby certify that this correspondence including a Brief on Appeal (in triplicate), and this transmittal letter (duplicate) is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450 on 9/13/05.

J. B. KRAFT

J. B. Kraft 9/13/05
Signature Date

TRANSMITTAL OF APPELLANTS' BRIEF UNDER 37 CFR 1.192(a)

PATENT
09/589,666

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

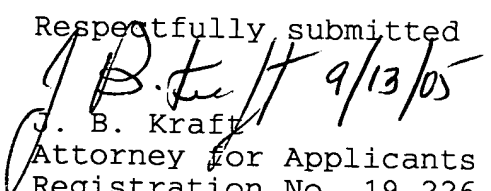
Sir:

Attached is Appellants' Brief (in triplicate) in this Appeal from a decision of the Examiner dated April 14, 2005 finally rejecting claims 4-18, and 23-34.

Please charge our Deposit Account No. 09-0447 in the amount of \$500.00 for the Appeal Brief fee. (a duplicate of this transmittal is included.)

The Commissioner is hereby authorized to charge any additional fee which may be required or credit any overpayment to Deposit Account No. 09-0447.

Respectfully submitted

 9/13/05
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BRIEF ON APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an Appeal from the Final Rejection of Claims 4-18, and 23-34 of this Application. An Appendix containing a copy of each of the Claims is attached.

I. Real Party in Interest

The real party in interest is International Business Machines Corporation, the assignee of the present Application.

II. Related Appeals and Interferences

None

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III. Status of Claims

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

There are 27 claims in this Application.

B. STATUS OF ALL THE CLAIMS

1. Claims cancelled: 1-3, and 19-22.
2. Claims withdrawn from consideration but not cancelled: None.
3. Claims pending: 4-18, and 23-34.
4. Claims allowed: None.
5. Claims rejected: 4-18, and 23-34.

C. CLAIMS ON APPEAL

Claims on appeal: Claims 4-18, and 23-34.

IV. Status of Amendment

No amendments have been filed after Final Rejection.

V. Summary of Invention

Every independent claim 4, 9, 16, and 23 requires the the accessing and/or transmission from a source on the World Wide Web (Web 50, Fig.1) of a markup language document such as a Hypertext Markup Language (HTML) document (the HTML document, described on pages 7-8 of present specification, the code of which is listed) containing two versions of the data content: a first version (screen shown in Fig. 2) of the content which is displayable at standard display stations (display computer 31, Fig. 1) on the Web, and a condensed version of the same data content (22, Fig. 3) displayable on smaller palm-type displays (42, Fig. 1) accessing the Web. Independent claims 4, 9, and 14 respectively define a system, method and program for accessing such a HTML Web document with two versions through a palm-type device so that the condensed version may be displayed at the palm device. Independent claim 23 further sets forth that the HTML document is available from source on the Web (the developer or owner of the Web document, described on page 10, lines 8-13).

In addition dependent claims 5, 10, 15, and 24-26, to be argued separately, describes Web HTML documents with first and second tags defining first and second versions (page 8, line 35 to page 10, line 9 of the Specification in reference to the HTML code for the Web page describe an example of how the two versions are defined by their respective tags.)

Dependent claims 25-28, to be argued separately, define an additional aspect of the invention wherein there is at least one additional set of natural language data identified by at least one additional set of tags. (Page 9, lines 11-24 which recognizes that different palm devices will be only able to display condensed versions applicable to the

particular palm device. This requires additional versions for the different palm-type devices identified by specific tags.)

VI. Grounds of Rejection

Claims 4-18 and 23-34 are rejected under 35 U.S.C. 103(a) as unpatentable over Kikinis (US6,076,109) in view of Donoho et al. (US6,604,130).

VII. Argument

Claims 4-18 and 23-34 are unobvious under 35 U.S.C. 103(a) over over Kikinis (US6,076,109) in view of Donoho et al. (US6,604,130) and, thus, are patentable.

Every claim in this Application requires the transmission of a markup language document such as a Hypertext Markup Language (HTML) document containing two versions of the data content: a first version of the content which is displayable at standard display stations, and a condensed version of the same data content displayable on smaller palm-type displays.

While Kikinis recognizes the need to condense data content of HTML documents to fit smaller personal device displays, Kikinis does not provide the two versions in a single HTML document. Rather, in the Kikinis system, when the smaller hand-held device requests a copy of a particular HTML document, the requested document, instead of being routed through the conventional Web server (23, Fig. 4), is routed through a proxy server (19) wherein the document content is reduced or condensed so as to fit the confines of the hand-held display. Thus, the Kikinis HTML documents only contain one version which is subsequently condensed to another version in the proxy server 23 when there is a request from a hand-held computer.

On page 3 of the current Office Action, the Examiner agrees with Applicants that this is the primary shortcoming of the Kikinis patent i.e. it:

"...does not teach that the two sets of natural language are combined and contained within the same markup language document file."

However, Examiner looks to the teaching of Donoho (6,604,109) to make up for this deficiency of Kikinis. Donoho does not disclose this claimed element. The Donoho patent is a very extensive description (100 columns and 26 pages of drawing relative to how information broadcast over the Web or Internet may be selectively scanned, chosen, organized, summarized, and, of course, tailored to meet the specific needs of users referred to as Advice Consumers of clients. This is carried out by a sophisticated system of intelligent servers which serve as agents for the advice consumers. In this extensive general disclosure which is not related to the present invention, the Examiner has extracted a segment at col 22, lines 15-22 which appears to only be pertinent if interpreted in light of Applicants' own teaching. There is a general statement of an E-mail message with alternative versions, the selection of which is determined by the destination. When read in the light of Donoho's teaching, this only means that Donoho's interpretive servers can select the appropriate version suitable to the needs of the advice consumer. There still is no suggestion of the element of the present invention wherein there are means in the personal palm-type computer for directly accessing the second i.e. condensed version of the displayable data from the received markup language document.

Combination of Kikinis and Donoho Made Solely in Light of Applicants' Own Teaching

Applicants submit that such a proposed combination of Kikinis and Donoho references is being made not with the requisite foresight of one skilled in the art, but rather with the hindsight obtained solely by the teaching of the present invention. This approach cannot be used to render Applicants' invention unpatentable.

What the Examiner has done is used Applicants' disclosure as a guideline, and the picked and combined elements from each of the Kikinis and Donoho references based solely of Applicants' own teaching.

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art references of record convey nor suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore, 721 F 2d at 1553, 220 USPQ, pp. 312-313.

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 5 USPQ 2d 1596 (C.A.F.C.) 1988.

Accordingly, it is submitted that the suggestion for combining Kikinis with Donoho in the manner proposed by the Examiner could only come from Applicants' own teaching, and, thus, cannot form any basis for a combination of references.

There is No Teaching in the Combination of References of the use of Tags to Define the Two Versions of the Same Content

Dependent claims 5-8, 10-13, 15-18, 20, 22, and 24 include the further elements of a first and a second set of tags in each HTML document respectively identifying the two

data set versions of the same content. The claims are specific to the HTML document containing two sets of tags corresponding to and identifying the two respective sets, full desk sized and condensed natural language versions of the displayable information. Kikinis or Donoho contain nothing equivalent to such identifying tags. The Examiner has pointed to Fig. 2, col. 2, lines 32-67, and col. 8, lines 16-52 in Kikinis as teaching such tags. Applicants have reviewed these sections, and can not find anything equivalent to such tags.

There is No Teaching in the Combination of References of at least one additional set of natural language data identified by at least one additional set of tags.

Dependent claims 25-28 define an additional aspect of the invention wherein there is at least one additional i.e. a third set of tags identifying at least one additional selectable natural language version of the same content for different palm devices which will be only able to display condensed versions applicable to the particular palm device. This requires additional versions for the different palm-type devices identified by specific tags.

Again, Examiner points to the same sections in Kikinis, Fig. 4 and column 2, lines 32-67. As set forth above, this section and figure fail to teach two versions of content respectively identified by two tags. These citations do not teach any additional versions identified by additional tags.

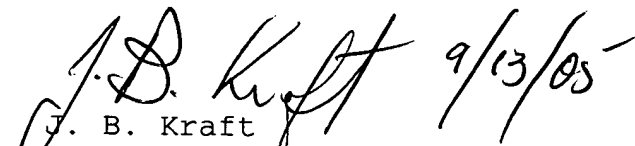
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Conclusion

In view of the foregoing, claims 4-18, and 23-34 are submitted to be unobvious under 35 U.S.C. 103(a) over Kikinis (US6,076,109) in view of Donoho et al. (US6,604,130) and, thus, are patentable.

Accordingly, the Board of Appeals is respectfully requested to reverse the final rejection and find claims 4-18, and 23-34 in condition for allowance.

Respectfully submitted,


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VIII. Claims on Appeal (Appendix)

1 4. In a World Wide Web communication network with user
2 access via a plurality of data processor controlled interac-
3 tive receiving display stations for displaying received
4 hypertext documents containing information of a particular
5 content represented by text and images, a system for con-
6 densing the displayed text/image representations of said
7 particular content to the smaller dimensions of personal
8 palm-type computer displays accessing said World Wide Web
9 network comprising:

10 a source on said World Wide Web for transmitting a
11 Hypertext Markup Language document including:

12 a first set of natural language data conveying a
13 first version of information of a particular content
14 displayable to users at said receiving display sta-
15 tions, and

16 a second set of natural language data conveying a
17 second version of condensed displayable information of
18 the same particular content displayable to users of
19 personal palm-type display computers connected to said
20 remote locations; and

21 a personal palm-type display computer with access to
22 the World Wide Web including:

23 means for accessing said second set of natural
24 language data from a received Hypertext Markup Language
25 document.

1 5. The system of Claim 4 wherein said Hypertext Markup
2 Language document further includes:

3 a first set of tags identifying said first set of
4 natural language data, and

5 a second set of tags identifying said second set of
6 natural language data.

1 6. The system of Claim 5 wherein said means whereby said
2 personal palm computer accesses the World Wide Web
3 comprises:

4 a browser associated with said personal palm computer
5 including:

6 means responsive said second set of tags to transmit
7 said second set of natural language data to said personal
8 palm computer.

1 7. The system of Claim 5 further including:

2 a receiving display station associated with said per-
3 sonal palm-type display computer, and

4 means whereby said personal palm computer accesses said
5 World Wide Web through said receiving display station.

1 8. The system of Claim 7 wherein said means whereby said
2 personal palm computer accesses the World Wide Web
3 comprises:

4 a browser for said associated receiving display station
5 including:

6 means responsive to said second set of tags to transmit
7 said second set of natural language data to said personal
8 palm computer.

1 9. In a World Wide Web communication network with user
2 access via a plurality of data processor controlled interac-
3 tive receiving display stations for displaying received
4 hypertext documents containing information of a particular
5 content represented by text and images, a method for con-
6 densing the displayed text/image representations of said
7 particular content to the smaller dimensions of personal
8 palm-type computer displays accessing said World Wide Web
9 comprising:

10 transmitting from a source on said World Wide Web, a
11 Hypertext Markup Language document including:

12 a first set of natural language data conveying a
13 first version of information of a particular content
14 displayable to users at said receiving display sta-
15 tions, and

16 a second set of natural language data conveying a
17 second version of condensed displayable information of
18 the same particular content displayable to users of
19 personal palm-type display computers connected to said
20 remote locations; and

21 accessing the World Wide Web with a personal palm-type
22 display computer including the step of:

23 accessing at said palm-type display computer said
24 second set of natural language data from a received
25 Hypertext Markup Language document.

1 10. The method of Claim 9 wherein said Hypertext Markup
2 Language document further includes:

3 a first set of tags identifying said first set of
4 natural language data, and

5 a second set of tags identifying said second set of
6 natural language data.

1 11. The method of Claim 10 further including:
2 accessing the World Wide Web through a browser includ-
3 ing the step of transmitting said second set of natural
4 language data to said personal palm computer responsive to
5 said second set of tags.

1 12. The method of Claim 9 wherein the network further
2 includes a receiving display station associated with said
3 personal palm-type display computer, and the method
4 includes:
5 the further step of accessing the World Wide Web by
6 said personal palm computer through said associated receiv-
7 ing display station.

1 13. The method of Claim 12 wherein said step of accessing
2 the World Wide Web by said personal palm computer comprises:
3 accessing the World Wide Web through a browser for said
4 associated receiving display station including the step of:
5 transmitting said second set of natural language data
6 to said personal palm computer responsive to said second set
7 of tags.

1 14. A computer program having code recorded on a computer
2 readable medium for providing condensed versions of display-
3 able information to personal palm-type computers connected
4 to a World Wide Web communication network comprising:
5 a Hypertext Markup Language document transmitted on
6 said World Wide Web including:
7 a first set of natural language data conveying a
8 first version of information of a particular content
9 displayable to users at said receiving display sta-
10 tions, and
11 a second set of natural language data conveying a
12 second version of condensed displayable information of
13 the same particular content displayable to users of
14 personal palm-type display computers connected to said
15 remote locations; and
16 means at a personal palm-type display computer with
17 access to the World Wide Web for accessing said second set
18 of natural language data from a received Hypertext Markup
19 Language document.

1 15. The computer program of Claim 14 wherein said Hypertext
2 Markup Language document further includes:
3 a first set of tags identifying said first set of
4 natural language data, and
5 a second set of tags identifying said second set of
6 natural language data.

1 16. The computer program of Claim 15 wherein said means
2 whereby said personal palm computer accesses the World Wide
3 Web comprises a browser including:
4 means responsive said second set of tags to transmit
5 said second set of natural language data to said personal
6 palm computer.

1 17. The computer program of Claim 15 wherein said network
2 further includes:
3 a receiving display station associated with said per-
4 sonal palm-type display computer, and
5 means whereby said personal palm computer accesses said
6 World Wide Web through said receiving display station.

1 18. The computer program of Claim 17 wherein said means
2 whereby said personal palm computer accesses the World Wide
3 Web comprises:
4 a browser for said associated receiving display station
5 including:
6 means responsive said second set of tags to transmit
7 said second set of natural language data to said personal
8 palm computer.

1 23. In a World Wide Web communication network with user
2 access via a plurality of data processor controlled
3 interactive receiving display stations for displaying
4 received hypertext documents containing information of a
5 particular content represented by text and images, a system
6 for condensing the displayed text/image representations of
7 said particular content to the smaller dimensions of
8 personal palm-type computer displays accessing said World
9 Wide Web network comprising:
10 a Hypertext Markup Language document on the World Wide
11 Web including:
12 a first set of natural language data conveying a
13 first version of information of a particular content
14 displayable to users at said receiving display
15 stations, and
16 a second set of natural language data conveying a
17 second version of condensed displayable information of
18 the same particular content displayable to users of
19 personal palm-type display computers connected to said
20 remote locations; and
21 a personal palm-type display computer with access to
22 the World Wide Web including:
23 means for accessing said second set of natural
24 language data from a received Hypertext Markup Language
25 document.

1 24. The system of Claim 23 wherein said Hypertext Markup
2 Language document further includes:
3 a first set of tags identifying said first set of
4 natural language data, and
5 a second set of tags identifying said second set of
6 natural language data.

1 25. The Hypertext Markup Language document of Claim ~~4~~ 4
2 further including:

3 at least one additional set of natural language data
4 conveying an additional version of condensed displayable
5 information of the same particular content displayable to
6 users of other personal palm-type display computers
7 connected to said remote locations, and

8 at least one additional set of tags identifying said at
9 least one additional set of natural language data.

1 26. The system of Claim 5 wherein the Hypertext Markup
2 Language document further includes:

3 at least one additional set of natural language data
4 conveying an additional version of condensed displayable
5 information of the same particular content displayable to
6 users of other personal palm-type display computers
7 connected to said remote locations, and

8 at least one additional set of tags identifying said at
9 least one additional set of natural language data.

1 27. The method of Claim 10 wherein the Hypertext Markup
2 Language document further includes:

3 at least one additional set of natural language data
4 conveying an additional version of condensed displayable
5 information of the same particular content displayable to
6 users of other personal palm-type display computers
7 connected to said remote locations, and

8 at least one additional set of tags identifying said at
9 least one additional set of natural language data.

- 1 28. The computer program of Claim 15 wherein the Hypertext
2 Markup Language document further includes:
3 at least one additional set of natural language data
4 conveying an additional version of condensed displayable
5 information of the same particular content displayable to
6 users of other personal palm-type display computers
7 connected to said remote locations, and
8 at least one additional set of tags identifying said at
9 least one additional set of natural language data.
- 1 29. The Hypertext Markup Language document of Claim 4
2 wherein said first set of natural language data includes a
3 portion of said second set of natural language data.
- 1 30. The system of Claim 5 wherein said first set of natural
2 language data includes a portion of said second set of
3 natural language data.
- 1 31. The method of Claim 10 wherein said first set of
2 natural language data includes a portion of said second set
3 of natural language data.
- 1 32. The computer program of Claim 14 wherein said first set
2 of natural language data includes a portion of said second
3 set of natural language data.

1 33. The system of Claim 6 further including:
2 a proxy server associated with said browser for
3 transmitting proxy condensed versions of Web HTML documents
4 to personal palm-type computers, and
5 means for overriding said proxy servers to thereby
6 permit the accessing by said palm-type computers of said
7 second set of natural language data conveying said second
8 version of condensed displayable data.

1 34. The method of Claim 11 including the further steps of:
2 normally providing a condensed version of Web HTML
3 documents to personal palm-type computers, and
4 overriding said proxy servers to thereby permit the
5 accessing by said palm-type computers of said second set of
6 natural language data conveying said second version of
7 condensed displayable data.